



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

5514 7590 12/20/2001

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
----------	--------------

2854

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,458

Applicant(s)

HAYASHI, EIJI

Examiner

MINH H CHAU

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-15, 17-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-12, 14, 15, 17-23 and 25) in Paper No. 4 (filed on 10/10/01) is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-8, 10-12, 14-15, 17-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani (US # 6,144,818).

With respect to claims 1, 11-12, 14-15, 17-18 and 25, Ohtani teaches method and a printing system comprising a host computer (2) and a printer (1) that are connected to each other, the host computer includes acquisition means for acquiring paper information, a staple position setting means, transmitting means for transmitting information relating to the staple position and the image data to be printed, and the printer includes printing means, a receiving means for receiving information relating to the staple position and stapling means for binding together a plurality sheets of printing

paper (see Figs. 1-4 and cols. 1-4). With respect to the recitation of "detection means" or "detection step" (claims 1, 14, 17 and 25), Ohtani teach in col. 4 that staple position or patterns is being determined base on the paper size, paper-feeding direction. In view of this teaching, it would have been obvious to one of ordinary skill in the art the teaching of the staple position is being determined base on the paper size that taught by Ohtani perform an obvious equivalent function of the "detection means" or "detection step" as recited in claims 1, 14, 17 and 25.

With respect to claim 2, see col. 2 of Ohtani that teach a plurality of paper trays (5) that capable of holding different type of paper sizes. With respect to the recitation "acquisition means... paper feed unit" (lines 5-6 of claim 2), Ohtani teach in col. 4 that the information relating to the papers stacked on the trays 5 are determined by the controller. In view of this teaching, it would have been obvious to one of ordinary skill in the art that the teaching of the determination of the information relating to the papers stacked on the trays 5 by Ohtani perform an equivalent function to the "acquisition means... paper feed unit" as recited in claim 2.

With respect to claims 3-4 and 19-20, see Fig. 11 and col. 5 of Ohtani that teach the selection of a paper tray to be use and the setting of the staple pattern for the printing paper.

With respect to claims 6 and 21, see Figs. 6-9 and cols. 3-4 of Ohtani that teach the staple position display means for displaying information relating to a position at which stapling can be performed and the staple position designating means for making it possible to input a user command for setting a staple position.

Art Unit: 2854

With respect to claims 7 and 8, see cols. 1-2 of Ohtani that teach information relating the feeding direction and the size of the printing papers.

With respect to claim 10, the use of the icon information for displaying a function of a particular features is well known in the prior art.

With respect to claim 22, Ohtani teaches the host computer is connected to the printer as show in Fig. 1. It is noted that a broad recitation of a plurality of a known feature is an obvious expedient.

With respect to claim 23, see Figs. 1-4 and col. 3 of Ohtani that teach the data that transmitting from the host computer to the printer is implemented by a printer controller.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani as applied to claims 1-3 above in view of Tabata et al. (US # 5,774,232).

With respect to claim 5, Tabata et al. teach an image recording apparatus including a binding location setting means (see Figs 13-14 and cols. 21-2 of Tabata et al). In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Ohtani to include the binding location setting means that taught by Tabata et al. so that an accurate staple position can be achieved when the binding function is being selected.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani as applied to claims 1-2 above in view of Kimoto et al. (US # 5,390,005).

Art Unit: 2854

With respect to claim 9, Kimoto et al. teach an image-forming machine including a function that indicating the type of the printing paper (see Fig. 16 of Kimoto et al.). In view of this teaching, it would have been obvious to one of ordinary skill in the art to modify the device of Ohtani to include the function that indicating the type of the printing paper that taught by Kimoto et al. for the advantage of allowing the stapling function can be properly achieved.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant's attention is invited to the patents to Nakajima (US # 5,481,354), Murata (US # 6,111,659) and Miyahara et al. (US # 6,314,213).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH H CHAU whose telephone number is 703-305-0298. The examiner can normally be reached on M-F 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN HILTEN can be reached on 703-308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841 for regular communications and 730-308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



MHC

December 17, 2001



JOHN S. HILTEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY OF